

REMARKS

The examiner rejected claims 1 through 24 under 35 U.S.C. 103(a) as being unpatentable over McGraw in view of Sherman (claims 1-9 and 13-16) or or over McGraw in view of Sherman and in further view of Dick (claims 10-12 and 17-24). Thus the examiner considers these claims to not be nonobvious in relation to the prior art.

Applicant hereby withdraws claims 1-12, amends the remaining claims and adds new claims.

Claims 13-24, which are for the combination of the thermal preservation insert and the plastic food container, have been amended to address the examiner's concerns. In particular, independent claims 13, 17 and 21 have been amended to add the phrase "the disk resting on the bottom of the plastic food container, said disk not fastened to a part of the plastic container".

It is respectfully submitted that the fact that the disk is not fastened in any way to a part of the plastic food container supports important previously disclosed advantages over the prior art and renders the invention as claimed in these independent claims 13, 17, 21 novel and nonobvious in relation to the prior art cited by the examiner.

McGraw discloses a thermally stabilized hot beverage serving vessel that has a temperature stabilizer 20 affixed to the inner lining of an insulated vessel at the bottom of the insulated vessel 32. (See column 3 lines 29-31). Temperature stabilizer 20 is secured to the inner lining 32 of insulated vessel 32 as an integral part of the inner lining 32. (See column 2 lines 23-27). Accordingly, not only does McGraw not disclose use of an insert that is not fastened to the container but McGraw specifically teaches away from same.

Sherman discloses a lunch box having a body and a vessel filled with a freezable liquid to

cool the interior of the body. The vessel 8 is mounted on one side of the cover 2. In an alternative embodiment, Sherman discloses the vessel as being "formed as a separate element insertable into the cover depression and connected with the cover by screws 20".

Neither the primary embodiment disclosed in Sherman nor even the alternative version disclosed in Sherman can be combined with McGraw to teach the elements of the invention, as defined by the amended independent claims 13, 17, 21. First, even in the alternative embodiment disclosed in Sherman the vessel is fastened to the cover of the container. In contrast, the insert 10 (disk 20) of the present invention is not fastened to any part of the container. In the primary embodiment of Sherman the vessel is mounted to the container. In McGraw the temperature stabilizer is integrally connected to the inner lining of the inner vessel. Even in the concluding paragraph of the description in McGraw which describes broad modifications to the described embodiment, it is emphasized that the stabilizer is affixed to the vessel's inner lining.

The advantage of having the disk or insert of the present invention not being fastened to the container (even though it fits snugly into the bottom of the container) is that this allows for its immediate removal and re-insertion or its re-positioning inside the container to an intermediate position (see claim 17). This can be critical if the user is for example at a salad bar and needs to quickly take salad or other food and keep it cool. He (or she) is not going to have a tool with him. Second, the use of screws to fasten the vessel of Sherman to the cover of the container is disadvantageous when storing food for several reasons. For one thing, food remnants such as grease can accumulate in crevices between the screws and the vessel or cover of Sherman. One important feature of the present invention disclosed in the specification is maintaining sanitary conditions while keeping the food cool or warm. The insert of the present invention is specifically

designed to conform exactly to the contour of the bottom of the plastic container not only to save space but also to avoid the accumulation of food grime and to make cleaning easier. Moreover, the fact that the insert of the present invention conforms snugly to the bottom of the container 70 makes attachment means, such as screws, unnecessary. In contrast, besides the presence of screws, there is actually a space shown in FIG. 4 of Sherman where grease from food can accumulate.

Furthermore, the insert of the present invention has smooth surfaces as much as possible to make cleaning easier and avoid the accumulation of food grime in crevices.

Another disadvantage of the use of screws or other attachment means to attach the insert of Sherman to the cover is that the screws increases the weight of the device. Plastic is lightweight and the addition even of something simple like screws, since they are metal, increases the weight unnecessarily. Furthermore, the presence of screws mandates the presence of something else - a tool to insert the screws. Such a tool is not always handy for folks storing food, as already suggested by the example of someone grabbing salad at the salad bar, or a person taking out stored food at a picnic. In contrast, the insert of the present invention is a disposable insert that is lightweight and simple to put in and take out and does not require access to tools or anything else. In general, moreover, tools and food simply do not go together. It is not always practical for someone going on a picnic to bring tools. Furthermore, the insert of Sherman cannot be stored conveniently in the refrigerator in one place as can the insert of the present invention. One would have to store inserts with screws in the refrigerator and that is not convenient - the screws could get lost - . The refrigerator is not really designed to store screws.

The features of the amended claim which distinguish over the prior art cited are also

supported by the specification. The original disclosure specifically mentions that the surfaces of the disk are smooth, that the present invention is easy to wash off and that the disk is designed to be sanitary and is designed to avoid accumulation of grease from food. For example, the discussion of the prior art at the last paragraph on page 2 notes with respect to problems in the prior art that need to be overcome that "known ice packs or hot pack inserts ... have crevices or ridges on the surface such that if one were to insert these freezer or hot packs into a plastic food container containing soup or solid food having liquid, the freezer or ice pack would acquire stains that would be hard to wash off.". In addition, Object and Advantage (12) at page 6: to provide a flat disk ... wherein the disk itself is smooth enough that it can be easily washed off from contact with liquid or solid foods". Object and Advantage (15) on page 6 is to "provide a thermal preservation insert for plastic food containers that is sanitary to use". The last paragraph on page discusses how the surfaces of disk are smooth enough to make the disk easy to clean and to avoid the accumulation of food stains.

Furthermore, the original disclosure at page 2, middle paragraph, last sentence, specifically notes that families which are hurrying to arrange food storage for a trip would prefer one less thing to worry about. The present invention is thus designed to be easy to use and reduce the things one has to worry about when taking food that is temperature sensitive. Having to worry about bringing along a tool and screws with the thermal insert would be contradictory to this need.

In sum, McGraw, even if it was modified by Sherman, would not teach the claimed features of the present invention as defined by the amended independent claims 13, 17, 21 for the combination of the plastic container and insert. Furthermore, Dick also does not teach the idea of

a thermal preservation insert that fits on the bottom of a plastic container without being fastened thereto. Accordingly, it is submitted that the independent combination claims 13, 17, 21, as amended, are distinguishable over the prior art.

In making the above argument, Applicant is not conceding that it is appropriate to combine McGraw and Sherman. Applicant only notes that even if such a combination were appropriate, it would not teach the elements of the claimed invention.

In this regard it is noted that in order for any prior art references themselves to be validly combined for use in prior art section 103 rejection, the references themselves, or some other prior art must suggest that they be combined. See In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983) ("prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.") The suggestion to combine the references should not come from applicant. See Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 1993, 199 (C.A.F.C. 1983) ("It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the results of the claims in suit [here the pending claims]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness.") See also Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988) ("[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself Something in the prior art must suggest the desirability and thus the obviousness of making the combination."). In this case, nothing in either McGraw or Sherman suggests a combination that amounts to the claimed invention as amended.

With respect to claim 17, Applicant also modified this claim to make it clear that the disk has a side that conforms to an intermediate portion of the sloping container wall of the plastic food container, and not to the lower portion and that while the disk rests on the bottom of the plastic food container, it is capable of being repositioned in the plastic food container, for example, if the container has a ridge, so as to rest on the intermediate portion of the sloping container wall of the plastic food container without being fastened to a part of the plastic container.

With respect to claim 21, Applicant also amended this claim to make it make sense in that a disk on the bottom cannot also fit on the intermediate portion if the wall is sloping. Thus the claim is amended to make clear that it refers to a second thermal preservation insert that conforms to the intermediate portion of the sloping container wall (it has to have a larger diameter unless there is a ridge) rather than describing it as being identical to the first freezer disk as previously claimed. This necessitated amending the first paragraph of page 11 of the specification to add the term "second disk" and explaining that this second disk has a larger diameter and conforms to the intermediate portion of the sloping wall. This was clearly previously implied in the specification by FIG. 4A which shows the top disk as being wider than the bottom disk.

The examiner also rejected claims 21-24 under 35 U.S.C. 112 as being indefinite because independent claim 21 line uses the phrase "the first freezer disc" which has no antecedent basis. This phrase has been deleted from amended claim 21 and hence no longer exists.

With respect to dependent claims 14, 15, 16, 18, 19, 20, 22, 23, these claims are dependent on independent claims 13, 17 and 21 and should be allowed if the independent claims from which they depend are allowed.

Furthermore, new dependent claims 25, 27, 29 introduce the element of the plastic food container being of a size and shape sold under the brand name Tupperware®, the brand name Glad® or the brand name Ziplock®. This is supported by the specification in several places such as page 1 line 6, page 10 line 1 and Object and Advantage (3) at pages 4-5. Accordingly, claims 25, 27, 29 are even more distinguishable over the prior art than independent claims 13, 17, 21.

Dependent claims 26, 28, 30 introduce the feature of being stackable due to the upper surface of the disk conforming to the lower surface of an identical disk. As explained in the last paragraph of page 10 of the specification, this allows the inserts to be stored in the freezer or refrigerator and be handy for use on short notice. This paragraph of the specification is also being amended to make clear that the "pattern of protrusions" simply means that the upper surface's contour conforms to the lower surface for stacking purposes.

New claim 31 for a multi-compartment container and inserts is taught by FIG. 6. Accordingly, the specification is being amended to describe a multi-compartment plastic food container, each compartment including a bottom and a compartment container wall, said compartment container wall having a lower portion that meets the bottom, where each insert is in each compartment.

With respect to method claims 32-37, although the specification is couched in terms of a device, the method claims describe a method whose three steps are supported fully in the specification. For example, the step of providing a plastic food container having the structure that is described in the specification introduces nothing new not supported in the specification. Similarly, the step of providing a thermal preservation insert having the structure that is described in the specification introduces nothing not supported in the specification.

Finally, the step of inserting the thermal preservation insert into the plastic food container so that the insert rests on the bottom of the container and is not fastened to the container is specifically suggested by the specification in several places. For example, on page 8 line 2 the specification recites that the "plastic food container 70 into which freezer insert 10 is designed to be placed includes a bottom 75 and a container wall 78, with the container wall 78 having a lower portion 78a that meets the bottom 75." The specification goes to state on the same page in paragraphs 2 and 3 of that page that the "freezer insert 10 of the present invention can be placed into one of two positions in the plastic food container 70.... Thermal preservation insert 10 in its simplest form is intended to rest on the bottom 75 of the plastic food container 70. Thermal preservation insert 10 comprises a disk 20 that is substantially flat on its upper surface, which disk 20 contains a freezable or heatable fluid, gel or coolant 22 that is completely buried inside the disk 20" the remainder of the description of the insert provided in the second step of method claims 32-37 is also given in the specification.

Furthermore, the steps of the method claimed in claims 32-37 involve working with a separate insert and not one that is integrally connected to the container. The third step of the method, in which the insert is placed so that it rests on the bottom of the plastic container without being fastened to a part of the plastic container, further distinguishes the method of the prior art cited by the examiner for the reasons previously stated with respect to the combination claims 13, 17, 21. Accordingly, it is respectfully submitted that method claims 32-37 distinguish over the prior art and should be allowed.

A request for extension of time in which to respond to the Office Action within the third month after the June 24, 2003 due date, together with the \$465 fee for a small entity,

accompanies this Amendment.

Since all of the foregoing amendments are understood to place the application in condition for allowance, their entry is submitted to be appropriate and is respectfully requested.

Dated: September 17, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'S. Horowitz', written over a horizontal line.

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